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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,787	05/04/1999	CARL J. EVENS	COS-98-009	1151

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EXAMINER

SOBUTKA, PHILIP

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/304,787

Applicant(s)

EVENS ET AL.

Examiner

Philip J. Sobutka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 103**

1. Claims 1,4,5,7,13,14,16-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taubenheim et al (US 6,060,997) in view of Fascenda (US 5,241,305).

Consider claims 1,5, 13,18. Taubenheim teaches a method for targeted marketing in a paging system, note that it is inherent in a paging system to generate unique identification numbers for subscribers allowing messages to be targeted to select subscribers using the identification number. Taubenheim's method comprises: creating advertising scripts (see especially col 4, lines 32-45), and appending the advertisement scripts to page messages (see especially fig 6) for paging service subscriber having unique identification numbers (see especially col 2, line 53 – col 3, line 8). Taubenheim lacks a teaching of the unique identification numbers being capcodes. Fascenda teaches that it is well known that each pager has an individual id called a capcode, and the each message intended for a particular pager has that pager's capcode associated with the message (Fascenda col 1, lines 15-25). It would have been obvious to one of ordinary skill in the art to modify Taubenheim to associate the capcode with the messages as taught by Fascenda in order to utilize a proven messaging technique.

As to claims 4,7, note that Taubenheim teaches the ad being transmitted after the message (see especially fig 6).

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As to claim 14,19,20, note that since each subscriber has a unique identifier, each capcode would correspond to the individual service.

As to claims 16,17,21,22 note that if an individual were sent several marketing pages, they would require a plurality of capcodes, one for each message.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taubenheim in view of Fascenda and in view of Lewis et al (US 5,594,,945).

Taubenheim in view of Fascenda teaches everything claimed except for the subscriber information including the capcode being stored in a central database. Lewis teaches subscriber information being correlated with a capcode stored in a central database in order to transmit messages (Lewis see especially col 7, lines 1-15). It would have been obvious to one of ordinary skill in the art to modify Taubenheim in view of Fascenda to store correlation of subscriber identity with capcodes as taught by Lewis in order to transmit messages to the subscriber.

3. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taubenheim in view of Fascenda and in view of DeLuca et al (US 5,870,030).

Taubenheim in view of Fascenda teaches everything claimed except for the ads being transmitted prior to the messages. DeLuca teaches transmitting ads prior to a message in order to ensure that the subscriber views the ad rather than viewing the message and ignoring the ad (DeLuca col 1, lines 35-38). It would have been obvious to one of ordinary skill in the art to modify Taubenheim in view of Fascenda to transmit the ads prior to a message in order to ensure that the subscriber views the ad as taught by DeLuca.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taubenheim in view of Yeh et al (US 6,208,717).

Taubenheim teaches everything claimed except for the capcodes corresponding to residential, small or large business service types. Yeh et al teaches differentiating a messaging service on the basis of residential, small and large business types (Yeh, see especially col 10, lines 6-14). It would have been obvious to one of ordinary skill in the art to modify Taubenheim in view of Fascenda to use a plurality of service types including residential, small and large business, as taught by Yeh, in order to allow for each customer category to have their needs more specifically met. Note that since the capcodes would be required for each delivery, of course the capcodes would correspond.

#### **Response to Arguments**

5. Applicant's arguments with respect to claims 1-7,13-22 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Sobutka whose telephone number is 703-305-4825. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers


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for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Philip Sobutka

Pjs  
October 31, 2002

  
WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600